

Appl. No. 10/723,994  
Amdt. dated August 26, 2005  
Reply to Office Action mailed May 26, 2005

### REMARKS

Applicants respectfully request reconsideration of this application in view of the foregoing amendments to claims and the following comments.

In the Office Action, claims 1-7, 25, 27 and 28 were rejected as allegedly obvious over U.S. Patent No. 6,007,434 to Baker ("the Baker patent"). Claims 20-21 and 22-24 were rejected as of allegedly obvious over the Baker patent, in view of Official Notices. Claims 1-4, 6-7, 25 and 28 were rejected as allegedly obvious over U.S. Patent No. 6,110,057 ("the McKinnon patent"). Claims 20-21 and 22-24 were rejected as allegedly obvious over the McKinnon patent in view of Official Notices. Claims 1-4, 6, 7 and 28 were rejected as allegedly obvious over U.S. Patent No. 4,964,641 to Miesch ("the Miesch patent"). Claims 20-21 and 22-24 were rejected as allegedly obvious over the Miesch patent in view of Official Notices.

By this Amendment, Applicants have added claims 29-39. No new matter has been added. Claims 8-19 and 26 have been canceled. Twenty-six claims are presented for reconsideration. Below, Applicants address the pending rejections.

#### **I. Obviousness Rejections of Claims 1-7, 20-25, 27, and 28 over the Baker Patent**

As mentioned above, claims 1-7, 25, 27 and 28 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Baker patent, and claims 20-21 and 22-24 were rejected as of allegedly obvious over the Baker patent in view of Official Notices.

Claim 1 is directed to a golf club head comprising a forward striking face and a rearward surface, opposite the forward striking face. The forward striking face includes an engineered texture having a recessed surface and a prescribed, regular pattern of discrete, geometric shapes projecting forward from the recessed surface. The geometric shapes are spaced apart from each other by at least 0.1 mm and each geometric shape has a volume of less than 0.0007 mm<sup>3</sup>. The engineered texture enhances the performance of the golf club head upon striking a golf ball, providing one or more of an increased backspin, a lower launch angle, and a higher ball speed, as compared to a golf club head having a striking face lacking such an engineered texture.

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The Baker patent discloses a putter having a plurality of pyramid-like projections disposed across a striking face. The pyramid-like projections are contiguous with no separation distance between adjacent structures and are configured to provide "improved top spin." (FIGS. 1, 2 and 6; col. 1, line 56.)

On page 2, last paragraph, the Examiner correctly asserts that the Baker patent "fails to clearly disclose a spaced apart distance of at least 0.1 mm and a volume of less than 0.0007 mm<sup>3</sup>." However, the Examiner further states:

"The applicant has disclosed these limitations as a preferred embodiment but the specification does not disclose any unexpected or surprising results from these limitations. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the any one of several the equivalent geometric designs based on cost and design considerations."

Applicants respectfully disagree with the above statement and respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness.

In establishing a *prima facie* case of obviousness, the Examiner must consider the invention as a whole, to include all claim limitations. *See*, MPEP 2143. Instead, a *prima facie* case of obviousness must establish a suggestion or motivation in the prior art based on actual evidence, to arrive at the claimed invention, including every limitation.

In this instance, the Examiner has failed to consider the limitations relating to the spacing and the volume of the geometric shapes of the textured surface and instead has dismissed them with the broad conclusory statement above. Applicants respectfully request that the Examiner identify in the *prior art* a suggestion or motivation for modifying the Baker patent in the manner prescribed. *See, In re Lee*, 277 F.3d 1338, 1344-45, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002) (finding that reliance on "common knowledge and common sense" did not fulfill the PTO's obligation to cite references to support its conclusions as the PTO must document its reasoning on the record to allow accountability and effective appellate review).

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The Baker patent fails to disclose, or even suggest, a golf club head having all of the features of claim 1, including a texture surface having geometric shapes spaced apart by a distance of at least 0.1 mm and having a volume of less than 0.0007 mm<sup>3</sup>. Instead, the Baker patent discloses pyramid-like projections that are contiguous, with no separation between adjacent structures, at all. Moreover, the Baker patent is silent on the volume of the pyramid-like structures.

If the Examiner chooses to rely upon common or personal knowledge to supply the shortcomings of the Baker patent, in accordance with 37 C.F.R. § 1.104(d)(2) and to preserve Applicants' argument on appeal, Applicants request that the Examiner provide an affidavit and/or references that evidence the asserted common knowledge (or personal knowledge of the Examiner).

Claims 2-7, 20-25, 27, and 28 depend, directly or indirectly, from independent claim 1, adding features that further define the invention and distinguish over the Baker patent.

Accordingly, the obviousness rejections of claim 1 -7, 20-25, 27, and 28 are improper and should be withdrawn.

## **II. Obviousness Rejections of Claims 1-4, 6-7, 20-25 and 28 over the McKinnon patent**

As mentioned above, claims 1-4, 6-7, 25 and 28 were rejected as allegedly obvious over the McKinnon patent, and claims 20-21 and 22-24 were rejected as allegedly obvious over the McKinnon patent in view of Official Notices.

On page 5, the Examiner correctly asserts that the McKinnon patent "fails to clearly disclose a spaced apart distance of at least 0.1 mm and a volume of less than 0.0007 mm<sup>3</sup>." However, the Examiner repeats the above-quoted statement, including that it would have been obvious to modify the golf club of McKinnon with "one of several the equivalent geometric designs based on cost and design considerations."

Applicants respectfully disagree with the above statement and respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness. It is not enough to

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assert that it would have been obvious to modify the McKinnon's club with "one of several the equivalent geometric designs based on cost and design considerations." None of the claims of the present application is directed to a golf club head that includes "equivalent geometric designs." Rather, claim 1, and its dependent claims, requires that the geometric shapes of the engineered texture are spaced apart from each other by at least 0.1 mm and each geometric shape has a volume of less than  $0.0007 \text{ mm}^3$ .

Applicants respectfully requests that the Examiner identify in the prior art a suggestion or motivation for modifying the McKinnon patent in the manner prescribed. *See, In re Lee*, 277 F.3d 1338, 1344-45 (Fed. Cir. 2002).

The McKinnon patent fails to disclose, or even suggest, a golf club head having all of the features of claim 1, including a texture surface having geometric shapes spaced apart by a distance of at least 0.1 mm and having a volume of less than  $0.0007 \text{ mm}^3$ . Instead, the McKinnon patent discloses a putter having a plurality of hollow, rigid spikes attached to a striking face. The McKinnon patent is silent on the distance between adjacent spikes and the volume of each spike. Assuming FIGS. 1-5 are within an order of magnitude to scale, each spike has a volume far greater than  $0.0007 \text{ mm}^3$ .

If the Examiner chooses to rely upon common or personal knowledge supply the shortcomings of the McKinnon patent, then in accordance with 37 C.F.R. § 1.104(d)(2) and to preserve Applicants' argument on appeal, Applicants request that the Examiner provide an affidavit and/or references that evidence the asserted common knowledge (or personal knowledge of the Examiner).

Claims 2-4, 6-7, 20-25 and 28 depend, directly or indirectly, from independent claim 1, adding features that further define the invention and distinguish over the McKinnon patent.

Accordingly, the obviousness rejections of claim 1-4, 6-7, 20-25 and 28 based on the McKinnon patent are improper and should be withdrawn.

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### **III. Obviousness Rejections of Claims 1-4, 6, 7, 20-24 and 28 over the Miesch Patent**

As mentioned above, claims 1-4, 6, 7 and 28 were rejected as allegedly obvious over the Miesch patent, and claims 20-21 and 22-24 were rejected as allegedly obvious over the Miesch patent in view of Official Notices.

On page 5, the Examiner correctly asserts that the Miesch patent "fails to clearly disclose a spaced apart distance of at least 0.1 mm and a volume of less than 0.0007 mm<sup>3</sup>." However, the Examiner repeats the above-quoted statement, including that it would have been obvious to modify the golf club of Miesch with "one of several the equivalent geometric designs based on cost and design considerations."

Applicants respectfully disagree with the above statement and respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness. It is not enough to assert that it would have been obvious to modify the Miesch's club with "one of several the equivalent geometric designs based on cost and design considerations." None of the claims of the present application is directed to a golf club head that includes "equivalent geometric designs." Rather, claim 1, and its dependent claims, requires that the geometric shapes of the engineered texture are spaced apart from each other by at least 0.1 mm and each geometric shape has a volume of less than 0.0007 mm<sup>3</sup>.

Applicants respectfully requests that the Examiner identify in the prior art a suggestion or motivation for modifying the Miesch patent in the manner prescribed. *See, In re Lee*, 277 F.3d 1338, 1344-45 (Fed. Cir. 2002).

The Miesch patent fails to disclose, or even suggest, a golf club head having all of the features of claim 1, including a texture surface having geometric shapes spaced apart by a distance of at least 0.1 mm and having a volume of less than 0.0007 mm<sup>3</sup>. Instead, the Miesch patent discloses a putter having a plurality of pyramid-like projections disposed across a striking face wherein the pyramid-like projections are contiguous with no separation distance between adjacent structures.

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With respect to volume, The Miesch patent discloses an on center spacing between adjacent pyramid apices of 0.040 to 0.160 inches (1.016 to 4.064 mm) and a pyramid height of 0.025 to 0.10 inches (0.635 to 2.54 mm). Pyramid volume is calculated as one-third of the base area times the height. Assuming the pyramids of the Miesch patent have square bases with a length equivalent to the on center spacing, the minimum possible volume for each pyramid is  $0.218 \text{ mm}^3$ , or approximately three-hundred times the volume of  $0.0007 \text{ mm}^3$  recited in claim 1. Consequently, The Miesch patent cannot be interpreted as disclosing features spaced apart by a distance of at least 0.1 mm and having a volume of less than  $0.0007 \text{ mm}^3$ .

If the Examiner chooses to rely upon common or personal knowledge supply the shortcomings of the Miesch patent, then in accordance with 37 C.F.R. § 1.104(d)(2) and to preserve Applicants' argument on appeal, Applicants request that the Examiner provide an affidavit and/or references that evidence the asserted common knowledge (or personal knowledge of the Examiner).

Claims 2-4, 6-7, 20-25 and 28 depend, directly or indirectly, from independent claim 1, adding features that further define the invention and distinguish over the Miesch patent.

Accordingly, the obviousness rejections of claim 1-4, 6-7, 20-25 and 28 based on the Miesch patent are improper and should be withdrawn.

#### **IV. New Claims 29-39**

By this Amendment, Applicants add new claims 29-39 directed to wedge-type golf club head having a forward striking face. The forward striking face comprises a recessed surface and a plurality of discrete geometric shapes projecting from the recessed surface. The geometric shapes each having a volume of less than  $0.007 \text{ mm}^3$ . The adjacent geometric shapes are separated by a distance of at least 0.1 mm.

None of the references cited disclose, or even suggest, a wedge-type golf club head having the all of the features of independent claim 29, let alone the dependent claims 30-39.

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V. Conclusion

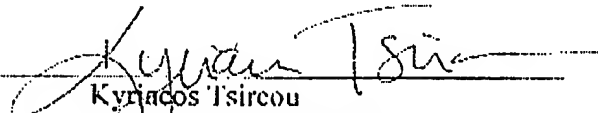
The foregoing remarks should place this application in condition for allowance. If any matters remain outstanding after consideration of this Amendment that the Examiner believes might be expedited by a telephone conference with Applicants' representative, he is respectfully requested to call the undersigned attorney at the number indicated below. As indicated in the transmittal form filed herewith, please charge any fees due in connection with this filing to our Deposit Account No. 19-1853.

Date: August 26, 2005

Respectfully Submitted,

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

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